

Appl. No. 10/665,670
Docket No. 9042M
Amendment dated April 28, 2008
Reply to Office Action mailed on December 26, 2007
Customer No. 27752

REMARKS

Claims 1, 2, 4-14, and 19-29 are pending in the present application. Claim 6 has been canceled.

Claim Objections

Claim 6 has been objected to under 37 CFR 1.75 (c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 6 has been canceled, thus, the objection to the claim has been rendered moot.

Claim Rejections

Rejection Under 35 USC §103(a) Chambers (U.S. Patent No. 5,612,307, hereinafter referred to as "Chambers") in view of Hayward (U.S. Patent No. 6,534,456 hereinafter referred to as "Hayward")

Claims 1, 2, 4-9, 14 and 19-29 are rejected under 35 USC § 103(a) as being obvious over Chambers in view of Hayward. The Applicants respectfully disagree and submit that the subject matter recited in the rejected, pending claims are not obvious over Chambers in view of Hayward.

The patent statute states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if such difference between the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall be not negated by the manner in which the invention was made. 35 USC §103(a)

A determination that a claim is obvious under §103(a) is a legal conclusion involving four factual inquires: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, or non-obviousness. *Graham v. John Deere Co.* 383 U.S. 1, 17-18 (1966). Secondary considerations of obviousness include factors such as commercial success, long-felt but unresolved needs, the failure of others, and/or unexpected results achieved by the claimed invention. *Id.* Furthermore, obviousness

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must be determined as of the time the invention was made and in view of the state of the art that existed at the time. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F. 2d 1044, 1050-51 (Fed. Cir 1988).

The Patent Office “has the burden under §103 to establish a prima facie case of obviousness.” *In re Fine*, 837 F. 2d 1071 1074 (Fed. Cir. 1988); MPEP §2142 (8th Ed. Rev. 6, Sept. 2007) (“the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.”). The Supreme Court recently identified a number of rationales that may be used to support a conclusion of obviousness, consistent with the framework set forth in its decision in *Graham v. John Deere Co.* (See *KSR int’l Co. V. Teleflex, Inc.* 127 S. Ct. 1727, 1739-40 (2007)). These and other representative rationales are described at MPEP § 2143 (8th Ed., Rev. 6, Sept. 2007). Regardless of the supporting rationale, however, the Patent Office must clearly articulate facts and reasons why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s filing date. (See *KSR Int’l Co. v. Teleflex, Inc.* 127 S. Ct. 1741). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness *In re Kahn*, et al., 441 F. 3d 977, 988 (Fed. Cir 2006). The key to supporting any rejection under 35 USC §103 is a clear articulation of the reasons why the claimed invention would have been obvious.

A combination of references may be used to support a rationale of obviousness. However, the test for obviousness is “what the combined teachings of those references would have suggested to those of ordinary skill in the art” (See MPEP § 2145). The combination of references cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. (See MPEP § 2143.01). Moreover, the combination of references cannot teach away from the combination of the elements. The Supreme Court recently stated “When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious” (See *KSR Int’l Co. v. Teleflex, Inc.* 550 U.S. at ___, 82USPQ2d at 1395). This idea is consistent with the framework set forth in

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Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR Int'l Co. v. Teleflex Inc.* Vol. 72, No. 195 issued on October 10, 2007 by the U.S. Patent and Trademark Office.

The action does not clearly articulate facts and reasons why the claimed invention "as a whole" would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention's filing date. Specifically, the action does not articulate findings of fact relating to the scope and content of the prior art and does not acknowledge clear difference between the claimed invention and the prior art. Still further, while the action appears to rationalize this conclusion of obviousness, the action does not articulate facts sufficient to support the asserted rationales (*See* MPEP 2143).

Examiner states that Chambers fails to teach a physical contact between the two phases. The Examiner states that Hayward is present in a single container and is packaged without partitions. The Examiner states that Hayward teaches that the components can be packages without barriers when the viscosities of the two phases are compatible and that the rheological behavior of the cleansing surfactants depends on the microstructure. The Examiner states that Hayward suggests ways to control the flow properties of both phases so as to be able to pump the compositions together. The Examiner states that it would have been obvious to one of an ordinary skill in the art at time of the instant invention to optimize the rheological properties of the phases and thus, extrude them together as stripes and still be able to maintain the viscosity.

The Applicants respectfully submit that the Chambers and Hayward are not properly combinable because the principle of operation of Chambers would be modified in view of Hayward. In the Chamber reference, the benefit agent and the base formulation comprising surface active agents are physically separate such that the base formulation and the benefit agent are not in direct contact with one another (*See* Chambers Claim 1). The cleansing and moisturizing components of Chambers are separate and dispensed as discrete domains. The benefit phase of Chambers is anhydrous. The lamellar and isotropic compositions of the Hayward reference are contained in a single container without any partitions, i.e. "partitionless package". The benefit phase of Hayward is aqueous.

Modifying the principle of operation of Chambers by placing the compositions of Chambers in a partitionless package is view of Hayward would render the compositions of Chambers unsatisfactory for their intended purpose. In reading Chambers, one of ordinary skill in the art would be discouraged from having a surfactant phase and benefit phase in physical contact within a partitionless package, as described in Hayward. The Chambers reference clearly teaches “the surface active agent and benefit agent are separated in the composition, i.e. they **do not directly contact one another in the composition**” (See Chambers column 1, lines 63-65). In fact, the Chambers reference states that the separate compositions of Chambers are not post mixed prior to use (See Chambers Claim 1). Chambers states that the separation of the surfactant and benefit phase “**avoids adverse interactions** which may occur between these two components and **resulting in ineffective deposition of the benefit agent**” (See Chambers column 1, lines 65-67). Thus, taken as a whole one of skill in the art would not combine the inconsistent teachings of Hayward and Chambers.

Despite the clear teaching in Chambers that phases are physically separate, the Examiner asserts that skilled artisan would disregard this teaching and would be able to arrive at the present invention. The Examiner states that one of ordinary skill in the art would be able to vary the principle of Chambers and still expect a being able to deposit benefit agents effectively. The Examiner states that the proposed modification of the prior art is merely an improvement of the prior art and does not affect the principle.

The Office Action has not explained why one of ordinary skill in the art would ignore the teachings of one piece of art and utilize teachings of another when the prior art is inconsistent and contradictory. The Office Action disregards the fact that the benefit phases of Chambers and Hayward are dissimilar in that the benefit phase of Chambers is anhydrous while the benefit phase of Hayward is aqueous. The Office Action has not explained why the differences in the nature of the benefit phases in the prior do not affect the principle of operation. The Office Action has not clearly articulated facts and rationale why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s filing date. The action therefore, does not set forth a prima facie case of obviousness.

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Accordingly, the Applicants respectfully traverse the rejection, and request reconsideration and withdrawal of the rejection.

Rejection Under 35 USC §103(a) Chambers in view of Hayward in view of Frantz, et al
(hereinafter referred to as "Frantz")

Claims 10-13 are rejected under 35 USC § 103(a) as being anticipated by Chambers in view of Frantz. As stated above, the combination of Chambers and Hayward do not teach or suggest the claimed invention in the independent claims from which 10-13 depend. The Frantz reference does not address the deficiencies of combining Chambers and Hayward. Thus, the details of the Frantz reference need not be addressed. The Applicants respectfully submit that the present application is patentably distinct over Chamber, Hayward and Frantz. The action therefore, does not set forth a prima facie case of obviousness. Accordingly the Applicants respectfully traverse the rejection, and request reconsideration and withdrawal of the rejection.

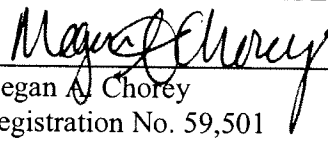
Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied reference(s). In view of the foregoing, entry of the amendment(s) presented herein, reconsideration of this application and allowance of the pending claim(s) are respectfully requested.

Respectfully submitted,

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